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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,493	09/16/2003	Joseph P. Errico	F-289	2440

51640 7590 02/12/2007
SPINE MP
LERNER, DAVID, et al.
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/663,493	Applicant(s) ERRICO ET AL.	
	Examiner Brian E. Pellegrino	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

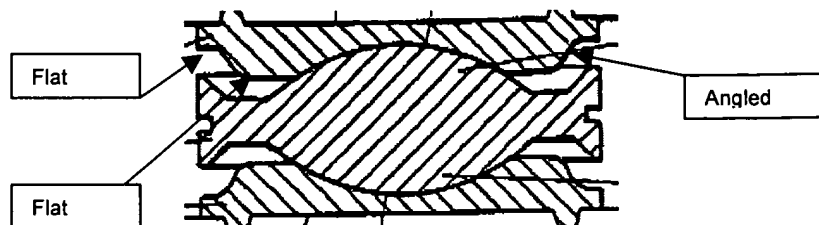
Terminal Disclaimer

The terminal disclaimer filed on 11/14/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/663487 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,13-15,18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller (4997432). Fig. 1 shows a spinal device with first and second baseplates 3 that are articulatable relative to one another and have angled perimeters that slope downward into the plate surface. Fig. 3 shows a manipulation tool that has an angled distal end with jaws being angled (Fig. 2) to correspond to the angled perimeter of the baseplates. It can also be seen (Fig. 5) that the angled perimeter of the baseplates has two flat ledges that flank a central flat sloping surface. Regarding claims 13,14,15,19,20 please note the intended use as set forth in the claims carries no weight in the absence of any distinguishing structure, such that the device is capable of being used in any of the claimed surgical approaches. It can be construed that the grooves form spacers between the plate surfaces since they form ledges to receive the plates.



Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-12,16,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller '432 in view of McGahan et al. (WO 01/62191). Keller is explained supra. However, Keller fails to disclose the baseplates having three flat perimeter surfaces with two of the perimeter surfaces forming corners. McGahan et al. illustrates (Fig. 15b) a spinal orthopedic set with a spinal implant **10** with angled perimeter surfaces having a central flat surface **22** flanked by two flat corner perimeter surfaces **18**, **26** that correspond to the angled distal end of the tool having central surface **128** and two flanked flat surfaces **126**, **130** to engage the implant. McGahan teaches that angled perimeter flat surfaces are provided to prevent rotation of the implant when inserting with the tool, page 12, lines 21-24. Regarding claims 9,10,17,18 please note the intended use as set forth in the claims carries no weight in the absence of any distinguishing structure. It would have been obvious to one of ordinary skill in the art to utilize angled flat perimeter surfaces on the plates and tool as taught McGahan and modify the spinal implant and tool set of Keller such that it provides the surgeon with more precise control of the spinal implant as the device is implanted. A modification of

the shape or engaging structure of the tool and that of the spinal implant would be within the skill of one of ordinary skill in the art since it would not change the ability of the device's baseplates from articulating with respect to one another.

Response to Arguments

Applicant's arguments filed 11/14/06 have been fully considered but they are not persuasive. In response to applicant's argument that the Keller reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., angled walls on the baseplates and the manipulation tool) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Please note that the claims recite "surfaces" and "ends" which are arbitrary locations that do not define any specific sites, just relative positions. As shown in the rejection, the prosthesis has angled perimeter portions and the tool is angled at its distal end. In response to applicant's arguments against the Keller and McGahan references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The McGahan reference was used for the teaching of providing cooperating surfaces between the tool and implant to prevent movement while inserting the device. Keller provides an articulating implant and tool for insertion, thus one of ordinary skill in

the art would look to teachings to be sure that such an implant does not move while inserting the prosthesis to assure proper placement in the patient.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Friday from 8:30am to 6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

BRIAN E. PELLEGRINO
PRIMARY EXAMINER

Brian E. Pellegrino